

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. THERMOS

Appeal No. 2000-2004
Application No. 08/975,284

ON BRIEF

MAILED

JUL 22 2002

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before CAROFF, PAK, and DELMENDO, Administrative Patent Judges.
CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-13, all the claims in appellant's involved application.

The examiner now indicates in his Answer that claim 13 is objected to as depending upon a rejected base claim, but would otherwise be allowable if rewritten in independent form including all the limitations of the base claim. Since claim 13 is no longer subject to rejection, the claims before us for consideration are claims 1-12.

The claims on appeal relate to a nozzle for injecting a nitrous oxide/fuel mixture into a cylinder of an internal combustion engine.

Claim 1 is illustrative of the subject matter encompassed by the appealed claims and reads as follows:

1. A nozzle for providing a nitrous oxide/fuel mixture to a combustion cylinder comprising;

a body member used in combination with a combustion engine having an inlet end and an outlet end, the body member defining an angular bore and a straight bore, the angular bore intersecting the straight bore and terminating at an inlet end such that fluid communication exists between the inlet end of the angular bore and the straight bore;

a tube concentric with the straight bore and terminating substantially flush with the outlet end of the body member and in fluid communication with an inlet end of the straight bore wherein the tube and body member in combination define an annular channel around the tube and a plurality of radially spaced outlet ports distributed around a central outlet port.

The following references are relied upon by the examiner as prior art:

Gauthier et al. (Gauthier) ¹	874,666	Dec. 24, 1907
Yerkins	3,477,112	Nov. 11, 1969
Pearce	3,838,820	Oct. 1, 1974
Magner	3,866,839	Feb. 18, 1975
Zwicker	4,248,384	Feb. 03, 1981

¹The examiner refers to the Gauthier patent as "Rodrigues-Ely", the second-named inventor listed on the patent. Traditionally, a patent is referred to by the name of the first inventor listed on the patent, as we do here.

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The following rejections are before us on appeal:

1. Claims 1, 5-8 and 12 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by Gauthier.

2. Claims 1, 4-8, 10 and 12 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by Yerkins.

3. Claim 2 stands rejected under 35 U.S.C. § 103 for obviousness over Gauthier in view of Zwicker.

4. Claims 3 and 9 stand rejected under 35 U.S.C. § 103 for obviousness over Gauthier in view of Magner.

5. Claims 4 and 10 stand rejected under 35 U.S.C. § 103 for obviousness over Gauthier in view of Yerkins.

6. Claim 11 stands rejected under 35 U.S.C. § 103 for obviousness over Gauthier in view of Pearce.

Before discussing the rejections before us, we find it necessary to apply the following new ground of rejection (which we designate as rejection no. 7) pursuant to the provisions of 37 CFR 1.196(b):

7. Claims 1-6 and 12-13 are hereby rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as his invention.

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Specifically, it is unclear from the language in base claim 1 whether the appellant is claiming a nozzle per se, or a nozzle in combination with a combustion engine. The preamble, which includes a statement of intended use, would suggest that only a "nozzle" per se is being claimed. On the other hand, the expression "a body member used in combination with a combustion engine" could be interpreted either way, viz. "used in combination" could be interpreted as merely a statement of intended use or as meaning that the claimed structure includes both the body member and a combustion engine. Adding to the confusion, the appellant states in his Reply Brief (page 2) that "the claim is explicitly limited to the combination of the combustion engine and the nozzle." If that is what the appellant intends, the language in the claim should be made crystal clear on that point so as to obviate any ambiguity.

In view of the foregoing new ground of rejection, we are compelled to reverse the examiner's rejections over prior art to the extent they have been applied against claims 1-6 and 12 since we are unable to ascertain the scope of those claims with sufficient precision to determine what differences may exist between the prior art and the claimed subject matter. Our analysis of those claims under 35 U.S.C. § 112 leaves us in a quandary as to

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what in fact is covered by them. Since rejections under 35 U.S.C. § 102 or 35 U.S.C. § 103 cannot be based on gross speculation or assumptions as to what the claims may or may not cover, our reversal is based on the concept that prior art cannot be applied to claims of indeterminate scope. In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962).

As for the prior art rejections under 35 U.S.C. § 102 of claims 7-8 over either Gauthier or Yerkins, we shall reverse those rejections as well since there is no disclosure of a "second coupling member" in either reference, as is required by appellant's claims.

The examiner speaks in terms of "inherency" when referring to a supposed need to connect a supply of fuel to passage "a" in Gauthier. However, this line of reasoning cannot serve as the basis for a rejection under 35 U.S.C. § 102. A coupling member is not anticipated or "inherently" present in Gauthier merely because a "need" may exist for some connection to a supply of fuel.

The examiner may be alluding to the possibility that a person of ordinary skill in the art would have found it obvious to provide a second coupling member in Gauthier, similar to the coupling associated with passage "b" (as shown in Figure 1), to connect passage "a" to a source of combustible gas.

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Accordingly, we remand the application to the examiner to consider a rejection of claims 7-8 under 35 U.S.C. § 103 for obviousness over either Gauthier or Yerkins based upon accepted criteria for establishing obviousness.

With regard to claims 9-11, since we are remanding the application to the examiner, he should also reevaluate the rejections which pertain to those claims consistent with the application of Gauthier as a reference under 35 U.S.C. § 103. Those rejections stand reversed subject to reevaluation by the examiner.

In summary, we have:

- (a) imposed a new ground of rejection under 35 U.S.C. § 112, second paragraph, as to claims 1-6 and 12-13.
- (b) reversed the examiner's rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 as to claims 1-12.
- (c) remanded the application to the examiner to consider imposing a new ground of rejection against claims 7-8, as well as claims 9-11, based upon criteria for establishing obviousness under 35 U.S.C. § 103.

For the foregoing reasons, the decision of the examiner is reversed, and the application is remanded to the examiner, via the Office of a Director of the involved Technology Center, for

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appropriate action consistent with our opinion. Also, note that we have entered a new ground of rejection pursuant to the provisions of 37 CFR 1.196(b).

This application, by virtue of its "special" status, requires immediate action on the part of the examiner pursuant to MPEP, § 708.01. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

REVERSED AND REMANDED

NEW GROUND OF REJECTION UNDER § 1.196(b)

Marc L. Caroff
MARC L. CAROFF

MARC L. CAROFF //
Administrative Patent Judge


CHUNG K. PAK

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